

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/EP2005/001228

International filing date (day/month/year)
08.02.2005

Priority date (day/month/year)
05.03.2004

International Patent Classification (IPC) or both national classification and IPC
C08K3/00, C08L83/04

Applicant
DEGUSSA AG

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☒ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITYInternational application No.
PCT/EP2005/001228

AP20 Rec'd PCT/PTO 05 SEP 2006

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

Box No. II Priority

1. ☐ The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

see separate sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/EP2005/001228

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-3
Inventive step (IS)	Yes: Claims	
	No: Claims	1-3
Industrial applicability (IA)	Yes: Claims	1-3
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VI Certain documents cited

1. Certain published documents (Rules 43bis.1 and 70.10)

and /or

2. Non-written disclosures (Rules 43bis.1 and 70.9)

see form 210

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

PCT/EP2005/001228

Cited documents:

- D1: WO 2004/033544 A (DEGUSSA AG; SCHOLZ, MARIO; MANGOLD, HELMUT) 22 April 2004 (2004-04-22)
- D2: US-B1-6 331 588 (AZECHI SYUICHI ET AL) 18 December 2001 (2001-12-18)
- D3: EP-A-1 085 053 (GE BAYER SILICONES GMBH & CO. KG) 21 March 2001 (2001-03-21)
- D4: WO 03/040048 A (METALLKRAFT AS; HENRIKSEN, KNUT) 15 May 2003 (2003-05-15)
- D5: US 2002/168524 A1 (KERNER DIETER ET AL) 14 November 2002 (2002-11-14)
- D6: EP-A-1 182 168 (DEGUSSA AG) 27 February 2002 (2002-02-27)
- D7: EP-A-0 900 829 (DOW CORNING CORPORATION) 10 March 1999 (1999-03-10)
- D8: US-A-5 976 480 (MANGOLD ET AL) 2 November 1999 (1999-11-02)
- D9: EP-A-0 691 365 (ERNST SONDERHOFF GMBH & CO. KG) 10 January 1996 (1996-01-10)
- D10: DE 43 23 229 A1 (BAYER AG, 51373 LEVERKUSEN, DE; MONETTE KABEL- U. ELEKTROWERK GMBH, 35) 19 January 1995 (1995-01-19)

1. Novelty (Art. 33 (2) PCT)

Each of cited documents D2 to D10 discloses a silicone rubber, characterized in that it contains a silica as filler as specified in detail in present independent main claim 1 (for relevant passages, see the corresponding International Search

Report).

The terms "structurally modified" and "hydrophobic pyrogenic" as specified in line 2 of present independent main claim 1 appear to be implicitly disclosed by each of said documents D2 to D10 in view of the principles of the established official rules of practice. Implicit (or inherent) disclosure corresponds to the fact, that the claimed product is regarded as being anticipated actually by said prior art documents, even if the claimed parameters or terms as specified in the said lines of present main claim 1 are not expressly mentioned therein, i.e., the parameters or terms are regarded as being actually present in the prior art embodiments, but simply not determined and/or mentioned expressly therein.

Consequently, each of said documents D2 to D10 anticipates the subject matter of present claim 1.

The same considerations also relate to the additional features of the following claims 2 and 3 when taking into account the full disclosure of each of said documents D2 to D10.

Therefore the subject matter of present application is not new in view of the disclosure of each of said documents D2 to D10.

2. Inventive Step (Art. 33 (3) PCT)

Providing an amended main claim which meets the requirements of Art. 33 (2) PCT, the applicant should relate the distinguishing feature to a surprising

(unexpected) technical effect or make credible or plausible that the distinguishing feature is not derivable from the prior art teaching (Art. 33 (3) PCT).

3. Miscellaneous

The terms "structurally modified" and "hydrophobic pyrogenic" as specified in line 2 of present independent main claim 1 appear to attempt a definition of the subject matter to be protected by means of the corresponding results to be achieved, rather than by means of clear and unambiguous technical features, such violating the Art. 6 PCT. Furthermore, the said terms do not represent clear and unambiguous technical features, but relative terms having no clear and unambiguous meaning among the average persons skilled in the art. The applicant therefore is invited to replace said objected terms by clear and unambiguous technical features based on suitable subclaims or relevant passages taken from the present description.

The attention of the applicant is drawn to the fact, that document D1 will be relevant for the assessment of novelty under the Arts. 54 (3, 4) EPC in the subsequent European regional stage, if any.

In order to improve the understanding and legibility of the application, in the European regional phase, if any, the applicant is invited to identify the documents D3 to D10 in the description additionally and briefly discuss the relevant background art disclosed therein.

When filing amendments, any undue extension of the scope of the application should be avoided.